

REMARKS

Claims 1-20 are pending in the present application. In view of the remarks which follow, reconsideration is respectfully requested.

Third Information Disclosure Statement

Applicants respectfully direct the attention of the Examiner to the fact that, after issuance of the pending Office Action on April 17, 2003, Applicants filed a third Information Disclosure Statement (IDS) on May 1, 2003. The reason that Applicants filed the third IDS shortly after issuance of the Office Action was to submit art from a corresponding PCT application before the end of specified time periods. The third IDS is mentioned here so that the Examiner will be aware it has been filed and will consider the third IDS with this Response.

Objection to Prior Information Disclosure Statement

In the first paragraph on page 2, the Office Action objects to Applicants' first Information Disclosure Statement (IDS), which was filed on November 13, 2000. In particular, the Office Action asserts that this first IDS did not comply with the provisions of MPEP §609 and 37 C.F.R. §§1.97 and 1.98, because the cited documents were not listed on Form PTO-1449. The Office Action indicates that this first IDS was placed in the PTO file, but was not considered on the merits. Applicants respectfully traverse this objection to the first IDS.

More specifically, in objecting to the first IDS, the Examiner has made an assumption that there is a

requirement that cited documents must be listed on Form PTO-1449. However, there is no such requirement. In this regard, the attention of the Examiner is respectfully directed to the provisions of MPEP §609(III)(A)(1), which begins by stating that every IDS must include a "list" of the cited documents, and which ends by stating that Applicants are "encouraged" to use Form PTO-1449 or some other similar form. Thus, there is a requirement for a "list", but there is no requirement that it be on Form PTO-1449. Applicants are merely "encouraged" to use Form PTO-1449. Similarly, the provisions of 37 C.F.R. §1.98(a)(1) specify that an applicant must provide a "list", but does not specify that the list must be on Form PTO-1449. Applicants also respectfully direct the attention of the Examiner to MPEP §609(III)(C)(2), which specifically recognizes that Applicant are not required to use Form PTO-1449. In particular, the MPEP states here that: "If the citations are submitted on a list other than on a form PTO-1449 or PTO/SB/08A and 08B, the examiner may write 'all considered' and his or her initials to indicate that all citations have been considered".

Thus, in the first IDS, Applicants provided a "list" of the cited documents, as required by MPEP §609 and by 37 C.F.R. §1.98. However, there is no requirement that the list must be on Form PTO-1449. Therefore, and contrary to the assertions in the Office Action, it is respectfully submitted that the first IDS filed on November 13, 2000 does comply with MPEP §609 and with 37 C.F.R. §§1.97 and 1.98. Consequently, the objection raised in the Office Action is improper, and must be withdrawn.

It is also noted that, although the Office Action states that the first IDS was placed in the PTO file and not considered on the merits, the Office Action was accompanied by an initialed copy of the list from the first IDS. Consequently, and with reference to the sentence from MPEP §609(III)(C)(2) which has been quoted above, it would appear from the written record that the Examiner did consider the first IDS on the merits.

Inconsistency in the Office Action

As discussed in the preceding section of this Response, the Office Action sent to Applicants was accompanied by an initialed copy of the list from Applicants' first IDS. Consequently, and with reference to the sentence quoted above from MPEP §609(III)(C)(2), it would appear that the Examiner did in fact consider the first IDS on the merits. On the other hand, the Office Action states that the first IDS was not considered on the merits, and instead was merely placed in the PTO file. In either case, the Office Action is internally inconsistent with itself.

In the event that the Examiner did not consider the first IDS on the merits, then the Office Action is incomplete. In this regard, the attention of the Examiner is respectfully directed to the provisions MPEP §609, §609(III)(B)(1) and §609(III)(C)(2), which make it clear that, when an IDS complies with the provisions of 37 C.F.R. §§1.97 and 1.98, the Examiner is required to consider the IDS before issuing the next communication on the merits, and the next communication must be accompanied by an initialed copy of the applicant's "list" of documents. In the present application, if the

Examiner actually did consider Applicants' first IDS on the merits, then the Examiner is requested to state this in his next communication. Otherwise, the Office Action is incomplete, and does not constitute a proper communication on the merits. In that case, the Examiner's next communication on the merits will technically be the first proper communication on the merits, and should be a non-final action.

Cross Reference to Related Applications

In the second paragraph on page 2, the Office Action objects to the specification, and effectively indicates that page 1 should be amended to include a list of the related applications which were cited in the first IDS filed on November 13, 2000. This ground of objection is respectfully traversed, for the following reasons.

First, in support of this objection, the Examiner cites MPEP §1503.01 and 37 C.F.R. §1.154(b)(2). However, these provisions of the MPEP and the rules apply only to design applications, whereas the present application is a utility application. The attention of the Examiner is respectfully directed to the provisions MPEP §608.01(a), which deal with utility applications and which include an explanation of when page 1 should have cross-references to related applications. Within this MPEP section, the attention of the Examiner is respectfully directed to form paragraph 6.02, which indicates that, on page 1 of the specification, cross-references to related applications relate to the provisions of MPEP §201.11 and 37 C.F.R. §1.78, which in turn relate to continuing application practice.

Thus, as to the PTO's preference for an indication on page 1 of cross-references to related applications, this preference is directed to those prior applications which, within a chain of continuing applications, are parents of the present application. In contrast, the related applications listed in Applicants first IDS are not within a chain of continuing applications that includes the present application. Consequently, and contrary to the assertions in the Office Action, there is no requirement that they be listed on page 1 of the specification. Applicants have therefore elected not to list them on page 1, as permitted by standard PTO practice.

Second paragraph of 35 U.S.C. §112

In the portion of the Office Action which bridges pages 2-3, the Examiner rejects Claims 1-20 under the second paragraph of 35 U.S.C. §112, asserting that these claims are indefinite because they each include the word "different". In particular, the Examiner asserts that the word "different" is a relative term, and that it therefore renders Claims 1 and 11 indefinite. This §112 rejection is respectfully traversed, for the following reasons.

First, there is no good basis for the assertion that the word "different" is a "relative" term. In this regard, the provisions of MPEP §2173.05(b) discuss various terms which the PTO considers to be "relative" terms that could potentially be indefinite. The word "different" does not appear among the various terms which are discussed here. The Examiner has not offered any support whatsoever for the assertion that "different" is a word which is routinely regarded by the PTO as a "relative" term.

The Examiner then goes on to assert: (1) that the word "different" is not defined in the claims, (2) that the specification does not provide a standard for ascertaining the requisite degree, and (3) that one of ordinary skill in the art would not reasonably understand the scope of the invention. The Examiner's statement on this point uses only standard "boilerplate" language, and does not contain a single word which is specific to the context of the claims that appear in the present application. In fact, the entire §112 rejection lacks a single word of explanation as to why, in the specific context of Claims 1 and 11, the word "different" might somehow present some indefiniteness. The Examiner basically assumes that the word "different" is automatically indefinite whenever it is used in a claim, but that assumption is contrary to standard PTO practice.

Further, it should be noted that Claims 8-9 and 18-19 of the present application each use the word "different", and the Examiner has not raised any objection to the word "different" in these claims. Consequently, it is respectfully submitted that the Examiner recognizes that the word "different" is not inherently indefinite. In order to establish that the word "different" is indefinite in Claims 1 and 11, even though it is not regarded as indefinite in Claims 8-9 and 18-19, the Examiner would need to discuss the specific context of the use of "different" in each of Claims 1 and 11, as mentioned above. However, the entire §112 rejection lacks even a single word of explanation which is specific to the context of Claims 1 and 11, and which explains why the word "different" should be considered indefinite in the specific context of Claims 1 and 11. It is therefore respectfully

submitted that Examiner has failed to carry the burden of establishing that the word "different" is indefinite as used in the specific context of Claims 1 and 11.

For the foregoing reasons, it is respectfully submitted that there is no reasonable basis for the assertion that the word "different" is a relative term, and thus no basis for the assertion that Claims 1 and 11 are inherently indefinite because they include the word "different". It is therefore respectfully submitted that Claims 1-20 are definite and comply with the second paragraph of §112, and notice to that effect is respectfully requested.

#### Double Patenting

The Office Action rejected Claims 1 and 11 under the judicially-created doctrine of obviousness-type double patenting, based on either Claim 1 or Claim 4 of co-pending U.S. Serial No. 09/657,661, when taken in view of Dougherty U.S. Patent No. 6,370,575. This ground of rejection is respectfully traversed, for the following reasons.

First, and as recognized in the Office Action, the double patenting rejection is a provisional rejection, because it involves two applications which are both still pending. The attention of the Examiner is respectfully directed to the provisions of MPEP §804(I)(B), which relate to this type of situation, and which essentially state that, when one of the two applications reaches a point where the only remaining rejection is a provisional double patenting rejection, the Examiner should withdraw the provisional double patenting rejection in the first application, and maintain a non-provisional double patenting rejection in the other

application. Consequently, if the present application reaches a point where the provisional double patenting rejection is the only remaining objection, the Examiner should withdraw it.

Turning to the basis for the double patenting rejection, the Examiner notes that Claim 1 of the present application and Claim 1 of the '661 application have some similar limitations, but concedes that Claim 1 of the '661 application does not include a limitation comparable to the recitation in Applicants' Claim 1 of "transmitting through a communications link from a first end thereof to a second end thereof a communication from a user which causes one of storing and execution of the project definition at said second end of the communications link". The Examiner asserts that, when Claim 1 of the '661 application is considered in view of the Dougherty patent, the subject matter of this limitation would be obvious.

In this regard, the Examiner asserts that Dougherty teaches the deployment and execution of a project definition file over a communications link (in the abstract and at lines 13-19 of Column 10). Applicants respectfully disagree. The abstract of Dougherty says nothing at all about a project definition file, much less deployment or execution thereof. Lines 13-19 of Column 10 mention a project definition file, but merely state that, for each new project within an organization, a project definition file is created. There is nothing in these portions of Dougherty to support the Examiner's assertion that Dougherty teaches a project definition file which is transmitted or deployed through a communications link. At best, Dougherty appears to teach that a communication sent through a communications link causes a

new project definition file to be created. This is different from what is recited in Applicants' Claim 1.

In particular, Applicants' Claim 1 requires that a project definition exist before a specified communication is sent through a communications link, and specifies that the communication causes the pre-existing project definition to be either stored or executed. It is thus respectfully submitted that the indicated portions of Dougherty do not teach the subject matter of the "transmitting" limitation which appears in Applicants' Claim 1. Consequently, even if Claim 1 of the '661 application is considered in view of the indicated portions of Dougherty, the result would not be the subject matter recited in Applicants' Claim 1.

A further consideration is that, in any obviousness analysis which involves a combination of teachings from two documents, the Examiner must not only propose how the teachings from the documents would be combined, but must also provide evidence that the prior art would motivate a person to make the proposed combination. (See MPEP §2143.01). In the present situation, the Examiner fails to do so. In particular, the Examiner merely makes the conclusory statement that "it would have been obvious to one skilled in the art to combine the recitation of the '661 application with the teaching of Dougherty thus enhancing the '661 application so the definition files might be loaded and executed remotely through a communications link". It is not clear that this sentence actually states a motivation for making the proposed combination, but even assuming that it does, the Office Action does not identify any specific portion of the prior art which is the origin for this motivation. Instead, the origin for

motivation here is apparently a personal belief of the Examiner, rather than anything found in the prior art. Consequently, in the absence of a clear explanation from the Examiner as to why there would be motivation which originates in the prior art, the obviousness analysis is incomplete and therefore defective.

Applicants also wish to point out that an obviousness analysis in the context of a double patenting rejection is not the same as an obviousness analysis for purposes of 35 U.S.C. §103. As one aspect of this, the ultimate issue in a double patenting rejection is whether two claims are both directed to essentially the same subject matter. Although Claim 1 of the present application and Claim 1 of the '661 application each include some limitations that are similar, they also each include some other limitations that are radically different. For example, and as noted above, Claim 1 of the present application includes a recitation of "transmitting through a communications link from a first end thereof to a second end thereof a communication from a user which causes one of storing and execution of the project definition at said second end of the communication link". In contrast, Claim 1 of the '661 application recites: "wherein one of said function definitions identifies a separate application program, wherein one of said function portions which corresponds to said one function definition identifies a command for said application program, and wherein execution of said one function portion causes execution of said command by said application program in a manner which affects data present in said one function portion". When these radically different limitations are taken into account,

it is respectfully submitted that Claim 1 of the present application and Claim 1 of the '661 application are not even remotely directed to the same basic subject matter, but instead are each directed to significantly different subject matter.

For the reasons set forth above, it is respectfully submitted that Claim 1 of the present application and Claim 1 of the '661 application are directed to respective different inventions, and that this remains true even if Claim 1 of the '661 application is considered in view of the Dougherty patent. It is therefore respectfully submitted that the double patenting rejection should be withdrawn with respect to Claim 1 of the present application.

Turning to Claim 11 of the present application, the double patenting rejection is based on Claim 4 of the '661 application when considered in view of the Dougherty patent, based on essentially the same rationale discussed above in association with Applicants' Claim 1. Therefore, and for reasons similar to those discussed above in association with Applicants' Claim 1, it is respectfully submitted that Applicants' Claim 11 is directed to an invention which is different from the invention recited in Claim 4 of the '661 application, even when Claim 4 of the '661 application is considered in view of Dougherty. It is therefore respectfully submitted that the double patenting rejection of Applicants' Claim 11 should be withdrawn.

Independent Claim 1 - 35 U.S.C. §103

Independent Claim 1 stands rejected under 35 U.S.C. §103 as obvious in view of a combination of teachings from

Mukherjee U.S. Patent No. 6,226,322, Koppolu U.S. Patent No. 6,446,135 and the Dougherty patent. This ground of rejection is respectfully traversed, for the following reasons.

The primary reference in this rejection is the Mukherjee patent. Figure 1 of Mukherjee discloses hardware circuitry which includes three modems 8 and 15, the modem 8 being coupled to each of the modems 15 by a respective twisted wire pair (TWP). Generally speaking, the Examiner asserts that the modem circuitry shown in FIGURE 1 of Mukherjee corresponds to the "project definition" recited in Applicants' Claim 1, including a plurality of function portions, a further portion and binding information. However, Claim 1 specifies that a communication received through a communications link "causes one of storing and execution of the project definition" which is recited in Claim 1. The hardware circuitry shown in Figure 1 of Mukherjee is not capable of being "stored" or "executed", and thus is not even remotely comparable to the "project definition" which is recited in Applicants' Claim 1. Therefore, since the §103 rejection relies on Mukherjee for the disclosure of certain subject matter, and since Mukherjee does not actually disclose this subject matter, the §103 rejection necessarily fails, regardless of what is disclosed in Koppolu and Dougherty. Nevertheless, Koppolu and Dougherty will be briefly discussed for purposes of completeness.

The Office Action states that "Mukherjee does not teach identification of a separate application program and a command identified with one of the functions". The Office Action then goes on to assert that Koppolu does disclose this feature. Applicants respectfully submit that this is all

irrelevant, because Claim 1 of the present application does not actually include a limitation directed to "a separate application program and a command identified with one of the functions". It is noted that the co-pending '661 application, which was discussed above in association with the double patenting rejection, includes independent claims with a limitation that refers to a separate application program and a command identified with one of the functions. But Claim 1 of the present application does not include any such limitation, and the indicated portion of Koppolu is thus believed to be entirely irrelevant to Claim 1 of the present application.

The Office Action goes on to assert that: "Neither Mukherjee nor Koppolu teaches the transmission of a project definition from one end of a communications link to another", and then asserts that Dougherty teaches this feature. Once again, however, the Examiner is discussing a feature which is not recited in Applicants' Claim 1. In particular, Applicants' Claim 1 never states that the recited project definition is necessarily transmitted through a communications link. Instead, Claim 1 recites that a communication is sent through a communications link, and causes one of storing or execution of a project definition. As discussed above in association with the double patenting rejection, the indicated portions of Dougherty do not disclose this feature. Consequently, this feature would not be obvious, even when the teachings of Dougherty are taken into account.

Still another consideration is that, as discussed earlier, a proper obviousness analysis under §103 must include not only a proposed combination of Mukherjee, Koppolu and Dougherty, but must also (1) establish motivation for making

the proposed combination, and (2) establish that the motivation has its origin in the prior art. In the Office Action, the §103 rejection of Claim 1 merely offers a conclusory statement that a person of ordinary skill would make the proposed combination. The Office Action does not establish any solid motivation, much less that there is motivation which has its origins in the prior art.

For the reasons discussed above, it is respectfully submitted that there are a number of flaws in the §103 rejection of Claim 1, and that Claim 1 is not rendered obvious under §103 by Mukherjee, Koppolu and Dougherty. Claim 1 is therefore believed to be allowable, and notice to that effect is respectfully requested.

Independent Claim 11 - 35 U.S.C. §103

Independent Claim 11 stands rejected under 35 U.S.C. §103 as obvious in view of a combination of teachings from Mukherjee, Koppolu and Dougherty. The rationale given in the Office Action for this rejection is identical to the rationale given for the rejection of Claim 1. Therefore, for the same basic reasons discussed above in association with Claim 1, it is respectfully submitted that Claim 11 is not obvious under §103 in view of Mukherjee, Koppolu and Dougherty. Claim 11 is therefore believed to be allowable, and notice to that effect is respectfully requested.

Dependent Claims

Claims 2-10 and Claims 12-20 respectively depend from Claim 1 and Claim 11, and are also believed to be

allowable over the art of record, for example for the same reasons discussed above with respect to Claims 1 and 11.

Conclusion

Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at (214) 953-6684.

Respectfully submitted,  
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Date: July 15, 2003

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